

### **Remarks**

The Office Action dated August 17, 2009 notes the following rejections: claims 13 and 24 stand rejected under 35 U.S.C. § 112(2); claims 1-4 and 24 stand rejected under 35 U.S.C. § 103(a) over Vilppula (U.S. Patent Pub. 2002/0019698) in view of Roel-Ng (U.S. Patent No. 6,002,936); claims 6-9 stand rejected under 35 U.S.C. § 103(a) over the '698, and '936 references and further in view of Ludwig (U.S. Patent No. 6,256,498); claims 10-11, 13, 15-17 and 22-23 stand rejected under 35 U.S.C. § 103(a) over the '698 reference; claims 18-20 stand rejected under 35 U.S.C. § 103(a) over the '698 reference in view of Yabe (U.S. Patent Pub. 2003/0013458); and claim 21 stands rejected under 35 U.S.C. § 103(a) over the '698, '936 and '458 references. In this discussion set forth below, Applicant does not acquiesce to any rejection or averment in this Office Action unless Applicant expressly indicates otherwise.

Applicant respectfully traverses the § 112(2) rejections of claims 13 and 24 because these claims do particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In this instance, the Examiner has improperly equated breadth of the claims with indefiniteness. *See, e.g.,* M.P.E.P. § 2173.04 ("Breadth of a claim is not to be equated with indefiniteness."). Notwithstanding, Applicant has amended claims 13 and 24 to remove the issue presented with the Office Action rejections based on § 112. Applicant requests that the rejection be withdrawn.

Applicant respectfully traverses the § 103(a) rejections of claims 1-4, 6-11, 13 and 15-24 because the cited references, alone or in combination, fail to meet all of the claim limitations and the proposed combination is illogical. For instance, the cited references fail to use context information to determine the order of the position determination devices.

To assist in the Examiner's understanding of the relevant issues, Applicant presents a brief explanation of aspects of Applicant's specification. Applicant's specification explains that, rather than iteratively cycle through what could potentially be all position determination devices, pre-ordering of the devices at specific times can be particularly useful for processing efficiencies. Thus, when an application requests position information a position determination device is selected according to the previously-ordered list.

The '698 reference does not respond to a change in context information by ordering the position determination devices. In response to a change in context, as defined by the Office Action, the '698 reference's PMSD "searches for the most suitable method from the available positioning methods . . . In other words, the PMSD automatically registers which positioning devices/methods are available for use." (paragraph 12). This selection process, however, does not correspond to ordering of the devices as is explained in more detail by the '698 reference.

A review of the corresponding details of this process of the '698 reference reveals that the process does not correspond to ordering of the devices. Instead, the result/output of the search is a single device, not an ordered list. More specifically, the '698 reference defines this searching as cycling through each available position determination device until one is found that meets the requested criteria, *see* Fig. 4. The selected device is then presented to the requesting application. Indeed, this search process appears to be repeated for each and every position request. Applicant submits that had the position determination devices been properly ordered (*e.g.*, as taught by Applicant's specification), then there would be no need to use a process that is designed to cycle through each available device to find a suitable match as the first device in the list would naturally be determinative of the suitability of the remaining devices. Therefore, there is no ordered list of position determination devices that meets the limitations of the claim, including ordering that is responsive to a change in context. Moreover, because there is no such list, when an application requests position information, a position determination device cannot be chosen from a list ordered as such. Accordingly, the '698 reference alone or in combination with the '936 references lacks correspondence to these limitations. Therefore, the rejections fail and Applicant requests that they be withdrawn.

With regards to independent claim 10, the '698 reference lacks correspondence. For example, the asserted reference does not teach the claimed invention "as a whole" (§ 103(a)) including aspects regarding, *e.g.*, a context message including context information from an application and establishing a priority of parameters as a function of said context message. In contrast, while the '698 reference discloses establishing a priority of parameters based on a message from an application, the reference makes no mention of the application sending context information to the location handling unit. The

Office Action acknowledges that the location handling unit only receives context information based upon whether a particular positioning method is available. In the '698 reference the application sends a message indicating the parameter value and quality of the position method required to the location handling unit, whereupon the location handling unit selects the most appropriate position determination device that is available. The message sent is based on the preferences of the application, irrespective of context information. Accordingly, no reasonable interpretation of the asserted prior art can provide correspondence, and the rejections fail.

The Office Action cannot overcome the lack of correspondence to the rejected claims simply by stating the missing limitations would be obvious. Applicant respectfully reminds the examiner that under M.P.E.P § 2141.02, the invention must be considered as a whole, and that "distilling an invention down to the 'gist' or 'thrust' of an invention disregards the requirement of analyzing the subject matter 'as a whole.'" M.P.E.P § 21.41.02(II) (*citing W.L. Gore & Associates, Inc. v. Garlock, inc.*, 721 F.2d 1540 (Fed. Cir. 1983)). The Office action has been focusing impermissibly on the use of a parameter to choose a position determination device, while ignoring steps to make the selection based on the parameter more efficient, and the situation in which the parameter is used. On examination of the '698 reference it is clear that the method for selecting the position determination device is an iterative process. While a particular parameter is used to make the selection of the position determination device, the steps to make the selection more efficient are lacking. The manner in which position determination devices are stored within the '698 reference's register does not change except to add a new device in the last position, or to remove a device that had been added earlier but is no longer available. As such, the rejection fails to establish correspondence to ordering of position determination devices in response to context information received from an application.

Applicant respectfully traverses the rejections that rely upon the combination of the '698 reference with that of the '936 reference because the combination is illogical. The two references teach two very different applications, and thus, the aspects taken from the '936 reference do not make sense in the context of the '698 reference. The '698 reference is directed towards a single locator device that can have multiple positioning mechanisms. The '936 reference is directed toward a cellular communication system in

which a base-station controller needs to acquire positions of the cellular phones in the various cells. Applicant submits that simply equating functionality associated with a base station within a cellular system (the '936 reference) with that of a small locator device (the '698 reference) ignores the context of the references. Thus, while a base-station controller may be taught to activate a cellular phone, Applicant submits that the skilled artisan would not look to these disparate teachings and would not apply base-station controller functions to those of a single locator device of the '698 reference.

The substance of the Office Action's description for these two very different applications shows that the Office Action is focused on the individual functionality of each reference. The Supreme Court has explained that inventions are almost always, if not always, made from a combination of elements that are known. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 419 (U.S. 2007). It logically follows that it will always be possible to find the elements of a claim by breaking down the elements individually. Accordingly, it is exceedingly important to consider the totality of a claimed invention including an explanation of how the references would function together. *See also*, M.P.E.P. § 2141.02. In pertinent part, the Office Action describes two distinct applications for determining position information that operate entirely independent of one another, but fails to explain how these distinct and independent applications would function together and also correspond to the claim limitations. For instance, the first part of the Office Action describes functions carried out on an individual device (the '698 reference), whereas other portions of the Office Action describe functions carried out by a base controller (the '936 reference). Thus, the Office Action appears to have impermissibly broken the claim limitations into individual elements without addressing the claims as a whole.

The amendments to claims 1 and 10 are directed toward limitations Applicant believes were already present in the claims. Regarding claim 1, the use of the label "context corresponding" when describing the selection process implies that for different contexts there may be a different selection process. Regarding claim 10, the amendment states that the context message is a message that includes the context information, which is implied from the adjective "context" that modifies the noun "message." Therefore, the amendments are not believed to be necessary for patentability and are presented instead

to facilitate prosecution. Support for the amendments can be found throughout the specification including, as non-limiting examples, the claims as originally filed and in paragraphs 15-17 of the specification.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Juergen Krause-Polstorff, of NXP Corporation at (408) 474-9062 (or the undersigned).

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